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On 7/14/08 (Date) Julie H. Gamotis
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Samir S. SHIBAN

Serial No. 10/796,120 Art Unit: 1793

Filed: March 10, 2004 Examiner: Edward M. Johnson

For: HAZARDOUS GAS ABATEMENT SYSTEM USING ELECTRICAL HEATER AND WATER SCRUBBER

RESPONSE

To the Director of the Patent and Trademark Office

Sir:

In response to the office action dated June 12, 2008, the applicant provisionally elects claims of Group I and traverses the requirement for restriction.

The inventions as described in the claims are neither independent nor distinct. In fact, the invention as claimed arises from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP 802.01 points out that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon his holding that the subjects are distinct. That is, as pointed out in Section 802.01, the examiner has held that the subject matter as claimed:

> are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under Section 803 that the claimed inventions:

> are able to support separate patents and they are ... distinct (MPEP Section 806.05-806.05(i)).

However, Section 803 unequivocally states:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

So that Section 803 makes its point clearly, the serious burden requirement is repeated under the title:

> CRITERIA FOR RESTRICTION BETWEEN
> PATENTABLY DISTINCT INVENTIONS

Section 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES that an examiner must provide reasons and/or examples to support

conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner. The examiner in this case is a senior examiner and is well skilled in examining Chemical Processes and Apparatus. The title of Class 422 is Chemical Apparatus and Process for ... Sterilizing.

The subclasses the examiner has cited are all closely related and are all within the subclasses which the examiner regularly searches, and all require searching and indeed are indented under each other in the classic outline form. Indeed, it would not be unreasonable for the examiner to search the subclasses that are closely related. Therefore restriction should not be required.

A pre examination search was conducted in Classes 422, subclasses 168, 169, 171, 173 and 174; Class 423, subclass 210, and Class 588, subclass 202. It is recommended that at least those subclasses be included in the examiner's search.

With regard to the examiner's specific points, in the following paragraphs it can be seen that restriction is not proper.

Inventions I and II are related because they all require the structure of Group I claims, and they all use the process of Group II claims.

Moreover, where inventions are related as disclosed but are not distinct as claimed, restriction is never proper (MPEP 806). The inventions are not distinct as claimed because each invention

as claimed requires the apparatus as claimed and the process as claimed. Moreover, there is no serious burden on the examiner because all of the inventions as claimed should be checked in the same subclasses.

MPEP 806 provides that if the inventions are not distinct as claimed, restriction is never proper.

The process as claimed in Group II claims is not distinct from the apparatus as claimed in Group I claims. For example, the process as claimed in claim 15 (Group II) is not distinct from the apparatus as claimed in claim 1 (Group I).

The examiner has not provided examples.

Moreover, Section 806.05(h) emphasizes "as claimed" and falls under the cautions of 806 and 806.05, both of which state, "where the inventions are related as disclosed but are not distinct as claimed, restriction is never proper".

In the present case the particular criteria and guidelines of 803 must be followed in that there must be a serious burden on the examiner if restriction were not required. In the present case, all of the groups must be searched in all of the subclasses which the examiner has pointed out. All are properly classified and searched together, and the search for one group would not be complete without searching all of the subclasses that the examiner has pointed out.

Moreover, from the title of the listed classes, it appears that the most important class is 422, which includes both

apparatus and process. There should be no hardship on the examiner to complete examination for both groups.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction requirement are requested.

Respectfully,

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